APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,158	01/26/2001	Larry A. Copp	10002193-1	8066

7590   02/16/2005

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EXAMINER
LEE, PHILIP C

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 December 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>14-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>14-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 14-32 are presented for examination and claims 1-13 are cancelled.

2.   The request filed on 12/27/04 for a Continued Prosecution Application (CPA) under 37

CFR 1.53(d) based on parent Application No. 09/771,158 is acceptable and a CPA has been

established. An action on the CPA follows.

3.   Applicant's arguments with respect to claims 14-32, filed 12/27/04, have been fully

considered but are not deemed to be persuasive and are moot in view of the new grounds of

rejection.

Claim Rejections – Non-Statutory Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).

6.   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

7.   Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,559,965 (Simpson et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because other than the additional phrase "wherein the print job contains a PML object, and wherein the PML object is UI_SELECT_OPTION", the two claims are not patentable distinct from each other. "Official Notice" is taken for the concept of a print job containing different PML object is known and accepted in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include a print job containing different PML object because by doing so it would increase the system efficiency by allowing embedded information to be transmitted with the print job in a single message.

Claim Rejections – 35 USC 112

8.   Claims 14-20 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

     a.   The following terms lack proper antecedent basis:

          i.   the print job – claim 14.

b..   Claim language in the following claims is not clearly understood:

i.   As per claim 14, lines 9-10, it is unclear what is "PML" [i.e. please expand

on the abbreviations].

ii.   As per claim 16, lines 10-11, it is has the same uncertainty as set forth in

claim 14 above.

iii.   As per claim 25, line 2, it is has the same uncertainty as set forth in claim

14 above.

Claim Rejections – 35 USC 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 21-24, 27, 29 and 31-32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Sorkin et al, U.S. Patent 5,898,823 (hereinafter Sorkin) and in view of Bacher

et al, U. S. Patent 6,728,012 (hereinafter Bacher).

11.   As per claim 21, Sorkin taught the invention substantially as claimed comprising:

sending a first message from a client to a peripheral server by way of a network, the first

message including a network address of the client (col. 4, lines 29-35, 56-58);

sending the first message from the peripheral server to a peripheral by way of the

network (col. 4, lines 33-35);

sending a second message from the peripheral to the client by way of the network, the

second message including a network address of the peripheral (col. 4, lines 36-39); and

accessing a non-printer function of the peripheral by way of the network using the client

and the network address of the peripheral and without using the peripheral server (col. 2,

lines 39-41; col. 4, lines 4-10, 48-51).

12.   Sorkin did not teach a multi-function peripheral. Bacher taught that the peripheral is a

multi-function peripheral (Abstract; col. 2, lines 45-54).

13.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Sorkin and Bacher because Bacher's multi-

function peripheral would increase the field of use in Sorkin's system.

14.   As per claim 22, Sorkin and Bacher taught the invention substantially as claimed in claim

21 above. Sorkin and Bacher further taught wherein:

the multifunction peripheral includes a printer function (see Bacher, abstract; col. 2, lines

45-54); and

the peripheral server includes a print queue (see Sorkin, col. 3, lines 52-55; col. 1, lines

26-32).

15.   As per claim 23, Sorkin and Bacher taught the invention substantially as claimed in claim

21 above. Sorkin further taught wherein the first message is formatted as a print job (col. 5, lines

20-22).

16.   As per claim 24, Sorkin and Bacher taught the invention substantially as claimed in claim

23 above. Sorkin further taught wherein the print job includes no content resulting in a printed

output (col. 2, lines 31-32).

17.   As per claims 27 and 32, Sorkin and Bacher taught the invention substantially as claimed

in claim 21 above. Bacher further taught wherein the non-printer function of the multifunction

peripheral is a scanning function, a facsimile function, or a copier function (Abstract; col. 2, lines

45-54).

18.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Sorkin and Bacher because Bacher's multi-

function peripheral would increase the field of use in Sorkin's system.

19.   As per claim 29, Sorkin and Bacher taught the invention substantially as claimed in claim

21 above. Sorkin further taught wherein the second message is generated directly by the

multifunction peripheral (col. 4, lines 36-39).

20.   As per claim 31, Sorkin and Bacher taught the invention substantially as claimed in claim

21 above. Sorkin further taught comprising placing the first message into a print queue of the

peripheral server prior to sending the first message to the multifunction peripheral (col. 1, lines

26-32; col. 3, lines 52-55).

21.   Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin and

Bacher in view of "Official Notice".

22.   As per claim 28, Sorkin and Bacher taught the invention substantially as claimed in claim

21 above. Sorkin and Bacher did not specifically detailing the formatted of the message as a

UDP datagram. "Official Notice" is taken for the concept of message formatted as a UDP

datagram is known and accepted in the art. It would have been obvious to one having ordinary

skill in the art at the time of the invention was made to include message formatted as a UDP

datagram because by doing so it would increase the efficiency by allowing faster transmission of

data message over the Internet.

23.   Claims 14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sorkin and Laser Jet Series 4050 Printer Model Specific MIB in view of "Official Notice".

24.   As per claims 14, Sorkin taught the invention substantially as claimed for a client to

discover a peripheral address, by way of a peripheral server, the method comprising:

> receiving a first message at the peripheral server, wherein the first message contains an
>
> address of the client (col. 2, lines 20-27); and
>
> receiving at the client a second message containing the peripheral address, wherein the
>
> first message is formatted as a print job, the print job including no content resulting in a
>
> printed output (col. 2, lines 27-32).

25.   Sorkin did not teach wherein the print job contains a PML object. Laser Jet Series 4050

Printer Model Specific MIB taught wherein the print job contains a PML object (page 51; page

124, paragraph 2; page 128, paragraph 3).

26.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Sorkin and Laser Jet Series 4050 Printer Model

Specific MIB because Laser Jet Series 4050 Printer Model Specific MIB's teaching of print job

containing a PML object would increase the efficiency of Sorkin's system by allowing

embedded information to be transmitted with the print job in a single message.

27.   Although, Laser Jet Series 4050 Printer Model Specific MIB taught wherein the PML

object is HELD_JOB_DELETE, however, Sorkin and Laser Jet Series 4050 Printer Model

Specific MIB did not specifically teach wherein the PML object is UI_SELECT_OPTION.

"Official Notice" is taken for the concept of using different type of PML object is known and

accepted in the art.   It would have been obvious to one having ordinary skill in the art at the

time of the invention was made to include different types of PML objects because by doing so it

would increase the field of use in their systems.

28.   As per claim 16, Sorkin taught the invention substantially as claimed comprising:

        a client computer (col. 4, lines 29-32)

        a peripheral server, connected to the client computer, wherein the peripheral server

receives a first message from the client computer, the first message containing an address of the

client computer (col. 4, lines 29-35, 56-58); and

        a peripheral, connected to the peripheral server, wherein the peripheral receives the first

message from the peripheral server and notifies the client computer of the peripheral's address

(col. 4, lines 36-39), wherein:

        the first message is formatted as a print job, the print job including no content resulting in

a printed output (col. 4, lines 59-61);

        the peripheral includes at least one non-printer function (col. 4, lines 4-10); and

        the client computer is configured to access the at least one non-printer function of the

peripheral using the peripheral's address and without using the peripheral server (col. 2, lines 39-

41; col. 4, lines 48-51).

29.   Sorkin did not teach wherein the print job contains a PML object. Laser Jet Series 4050 Printer Model Specific MIB taught wherein the print job contains a PML object (page 51; page 124, paragraph 2; page 128, paragraph 3).

30.   It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin and Laser Jet Series 4050 Printer Model Specific MIB because Laser Jet Series 4050 Printer Model Specific MIB's teaching of print job containing a PML object would increase the efficiency of Sorkin's system by allowing embedded information to be transmitted with the print job in a single message.

31.   Although, Laser Jet Series 4050 Printer Model Specific MIB taught wherein the PML object is HELD_JOB_DELETE, however, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB did not specifically teach wherein the PML object is UI_SELECT_OPTION. "Official Notice" is taken for the concept of using different type of PML object is known and accepted in the art.   It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include different types of PML objects because by doing so it would increase the field of use in their systems.

32.   As per claim 18, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB in view of "Official Notice" taught the invention substantially as claimed in claim 16 above. Sorkin further

taught wherein the peripheral server comprises a print queue (col. 3, lines 52-55; col. 1, lines 26-32).

33.   Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin and Bacher in view of Manglapus et al, U. S. Patent 6,219,151 (hereinafter Manglapus).

34.   As per claims 26 and 30, Sorkin and Bacher taught the invention substantially as claimed in claim 21. Sorkin and Bacher did not specifically detailing the message is generated by a separate interface device between the peripheral server and the peripheral. Manglapus taught wherein the second message is generated by peripheral with a built-in network interface (fig. 3; col. 5, lines 33-37; col. 10, lines 59-62).

35.   It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin, Bacher and Manglapus because Manglapus's system generating message with a network interface would increase the flexibility of Sorkin's and Bacher's systems by allowing the peripheral to connect to the network with different configuration.

36.   Claims 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB in view of "Official Notice" as applied to claims 14 and 16 above, and further in view of Bacher.

37.   As per claims 15, 19 and 20, Sorkin and Laser Jet Series 4050 Printer Model Specific

MIB in view of "Official Notice" taught the invention substantially as claimed in claims 14 and

16 above. Although, Sorkin taught wherein the peripheral is a printer, the peripheral server is a

print server comprising a print queue, and the first message is spooled to the peripheral from the

peripheral server by way of the print queue (col. 3, lines 27-32), however, Sorkin and Laser Jet

Series 4050 Printer Model Specific MIB did not teach wherein the peripheral is a multi-function

printer. Bacher taught wherein the peripheral is a multi-function peripheral (abstract; col. 2,

lines 45-54).

38.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model

Specific MIB and Bacher because Bacher's multi-function peripheral would increase the field of

use in their systems.

39.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin and Laser

Jet Series 4050 Printer Model Specific MIB in view of "Official Notice" as applied to claims 14

and 16 above, and further in view of Manglapus.

40.   As per claim 17, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB in view of

"Official Notice" did not teach wherein the interface generates a message to the client computer.

Manglapus taught wherein the second message is generated by peripheral with a built-in network

interface (fig. 3; col. 5, lines 33-37; col. 10, lines 59-62).

41.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model

Specific MIB and Manglapus because Manglapus's system of generating message with a

network interface would increase the flexibility of their systems by allowing the peripheral to

connect to the network with different configuration.

42.   Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin, Bacher

and Laser Jet Series 4050 Printer Model Specific MIB in view of "Official Notice".

43.   As per claim 25, Sorkin and Bacher taught the invention substantially as claimed in claim

23 above. Sorkin and Bacher did not teach wherein the print job contains a PML object. Laser

Jet Series 4050 Printer Model Specific MIB taught wherein the print job contains a PML object

(page 51; page 124, paragraph 2; page 128, paragraph 3).

44.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Sorkin, Bacher and Laser Jet Series 4050 Printer

Model Specific MIB because Laser Jet Series 4050 Printer Model Specific MIB's teaching of

print job containing a PML object would increase the efficiency of Sorkin's and Bacher's

systems by allowing embedded information to be transmitted with the print job in a single

message.

45.   Although, Laser Jet Series 4050 Printer Model Specific MIB taught wherein the PML

object is HELD_JOB_DELETE, however, Sorkin, Bacher and Laser Jet Series 4050 Printer

Model Specific MIB did not specifically teach wherein the PML object is

UI_SELECT_OPTION. "Official Notice" is taken for the concept of using different type of

PML object is known and accepted in the art.   It would have been obvious to one having

ordinary skill in the art at the time of the invention was made to include different types of PML

objects because by doing so it would increase the field of use in their systems.

CONCLUSION

46.   A shortened statutory period for reply to this Office action is set to expire THREE

MONTHS from the mailing date of this action. Any inquiry concerning this communication or

earlier communications from the examiner should be directed to Philip C Lee whose telephone

number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM

Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The

fax phone number for the organization where this application or proceeding is assigned is

(703)872-9306. Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703)350-6121.

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100